

## **REMARKS**

In the Office Action dated April 11, 2007, the Examiner rejected claims 1-3, 5-6, 8, 14-16 and 22-26 under 35 U.S.C. § 101, rejected claims 1-3, 5-6, 8, 17-19 and 22-28 under 35 U.S.C. § 112, first paragraph, and rejected claims 9, 11-12, 21 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Capeocchi (U.S. Patent No. 5,464,764) in view of Seth et al. (2000, Biochemical and Biophysical Research Communications 241: 535-540). The Examiner found claims 13 and 30 to be allowable, but objected to such claims because of their dependence on rejected claims. In response to these rejections, as indicated in the claim chart and remarks below, Applicant has amended some of the claims, cancelled claims 11-13, 22-27, and 30, and added new claims 31 and 32, but no new matter has been added. Applicant has also amended the Specification in accordance with 37 C.F.R. § 1.804(a) and *In re Lundak*, 773 F.2d 1216, 227 USPQ 90 (Fed Cir. 1985).

## **CLAIM CHART**

$1_{\text{NEW}} = 1_{\text{OLD}} + 30_{\text{OLD}}$
$9_{\text{NEW}} = 9_{\text{OLD}} + 13_{\text{OLD}}$
$31_{\text{NEW}} = 21_{\text{OLD}} + 1_{\text{NEW}}$
$32_{\text{NEW}} = 21_{\text{OLD}} + 9_{\text{NEW}}$

### **35 U.S.C. § 101**

Claims 14-16 have been rejected under 35 U.S.C. § 101 because these claims are drawn to “host cells.” In the Office Action (page 2) dated April 11, 2007, the Examiner states that “the insertion of a phrase such as ‘an isolated host cell’ or ‘cell of a non-human mammal’ would overcome this rejection.” Applicant has amended claims 14-16 accordingly. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Claims 1-3, 5-6, 8 and 22-26 were rejected under 35 U.S.C. § 101 and *Diamond v. Chakrabarty*, 447 U.S. 303, 206 U.S.P.Q. 193 (1980). In the Office Action (page 3) dated April 11, 2007, the Examiner states that “the claims should be amended to indicate the hand of the inventor, e.g., by insertion of ‘transgenic’ in case of a live animal.” Applicant has amended claims 1-3, 5-6, and 8 accordingly and canceled claims 22-26. Therefore, Applicant respectfully requests that the rejection be withdrawn.

### **35 U.S.C. § 112**

Claims 1-3, 5-6, 8, 17-19 and 22-28 have been rejected under 35 U.S.C. § 112, first paragraph. However, the Examiner found claim 30 to be allowable but objected to because of its dependence on the rejected claim 1. Applicant has amended claim 1 to include the claim limitations of claim 30, and canceled claim 30 accordingly (see claim chart). Therefore, Applicant respectfully requests that the rejection for claim 1 be withdrawn.

Moreover, because claims 2-3, 5-6, 8, and 17-19 depend from claim 1, Applicant respectfully requests that the rejection for these claims be withdrawn. Further, Applicant has canceled claims 22-28.

### **35 U.S.C. § 103**

Claims 9, 11-12, 21 and 29 have been rejected under 35 U.S.C. § 103(a). However, the Examiner found claim 13 to be allowable but objected to because of its dependence on the rejected claim 9. Applicant has amended claim 9 to include the claim limitations of claim 13 (see claim chart), and cancelled claims 11-13. In turn, claims 21 and 29 are also non-obvious because they depend from claim 9, and thus are more narrow than the allowed subject matter. Therefore, Applicant respectfully requests that the rejection be withdrawn.

### **Deposit**

Applicant has deposited the vector pHR53TK in accordance with 37 C.F.R. §§ 1.801 – 1.809. Applicant respectfully provides a Receipt of Deposit in support of this statement.

### **Conclusion**

In view of the remarks set forth below, Applicants respectfully submit that the present invention is in condition for allowance.

Applicants authorize any overcharges to be charged to, and any credits to be applied to deposit account no. 50-1519.

Respectfully submitted,

/Mark Bergner/ (Reg. No. 45,877)

Mark Bergner  
SCHIFF HARDIN LLP  
PATENT DEPARTMENT  
6600 Sears Tower  
Chicago, Illinois 60606-6473  
(312) 258-5779  
Attorney for Applicants  
**Customer Number 26574**